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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/558,930	02/01/2007	Jean-Luc Albert Vital Marchal	1143-PCT-US	8495

7590 07/27/2009  
Law Offices of Albert Wai-Kit Chan  
World Plaza Suite 604  
141-07 20th Avenue  
Whitestone, NY 11357

EXAMINER
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PICKETT, JOHN G

ART UNIT	PAPER NUMBER
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3728

MAIL DATE	DELIVERY MODE
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07/27/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/558,930	<b>Applicant(s)</b> MARCHAL, JEAN-LUC ALBERT VITAL	
	<b>Examiner</b> J. Gregory Pickett	<b>Art Unit</b> 3728	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 18-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 18-22 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Applicant's election with traverse of Group I, claims 1-17 in the reply filed on 14 May 2009 is acknowledged. The traversal is on the ground(s) that unifying feature is more than that assumed by the Examiner. This is not found persuasive because Suzuki (JP 11-321952 A) is used to make colored pavement (paragraph [0001]), and as admitted by the applicant in the Background Art, it was well known that clear synthetic binders were used in the production of colored pavement. Accordingly, Suzuki inherently contains a clear binder and as noted in 37 CFR 1.475(a), the expression "special technical feature" shall mean those technical features that define a contribution ... over the prior art (see also PCT Rule 13.2).

The requirement is still deemed proper and is therefore made **FINAL**.

Claims 18-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

### ***Oath/Declaration***

2. The Office is hereby *sua sponte* waiving the express language requirement of 37 CFR 1.63(b)(3), where the oath or declaration was filed prior to 01 June 2008. The express language of 37 CFR 1.63(b)(3) is waived only to the extent necessary such that an oath or declaration containing the "material to examination" or "in accordance with § 1.56(a)" language, or both, will be accepted as acknowledging the applicant's duty to disclose information "material to patentability" as defined in 37 CFR 1.56. Applicants

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are advised that, notwithstanding the preceding waiver, an applicant who has not disclosed information that is material to patentability as defined in 37 CFR 1.56, because it was believed that the information was not “material to the examination,” should disclose such information in order to discharge the applicant’s duty of disclosure as required by 37 CFR 1.56, and should file a supplemental oath or declaration acknowledging that duty of disclosure.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3, 10, 11, and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 10 recite an improper Markush group. Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being “selected from the group consisting of A, B and C.” See *Ex parte Markush*, 1925 C.D. 126 (Comm’r Pat. 1925). It is improper to use the term “comprising” instead of “consisting of.” *Ex parte Dotter*, 12 USPQ 382 (Bd. App. 1931). See MPEP 2173.05(h).

Claims 11 and 14 recite the limitation "said packaging material" in line 2. There is insufficient antecedent basis for this limitation in the claim. The claim should be amended to recite --said container--.

Regarding claim 15 and further regarding claims 3 and 10, use of the terminology, "combinations thereof" renders the claim(s) indefinite since it is unclear as to whether the group is limited to only combinations of the listed items or includes combinations of the listed items with additional items not listed in the specification. Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims.

Regarding claim 16, use of the terminology "of any suitable size or shape" renders the claim indefinite. There is no way for one of ordinary skill in the art to ascertain the bounds of the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-8, and 10-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki (JP 11-321952 A) with Lemoine et al (US 2002/0052431 A1) used in an evidentiary manner (MPEP 2131.01).

Suzuki discloses a consumable package comprising a clear binder (paragraphs [0005] and [0014]) and a packaging material/container (bag, paragraph [0005]). Suzuki discloses a container/packaging material (bag) that is made of ethylene-vinyl acetate copolymer (paragraph [0018]), which is disclosed by the applicant as suitable and therefore inherently possesses the claimed melting point. Further, Suzuki is used in the production of colored pavement (paragraph [0001]), and as evidenced by Lemoine et al (US 2002/0052431 A1, paragraph [0002], last two sentences), it was well known that clear synthetic binders were used in the production of colored pavement (note: applicant admits as much in the Background Art). Claim 15 is a product-by-process claim and Suzuki discloses a casting method (paragraph [0019]).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (JP 11-321952 A).

Suzuki, as applied to claims 1 and 8 above, uses a weight measurement to define bag size instead of volume. However, the provision of the bag within the claimed volume would entail a mere change in size that is wholly dependent upon the amount of

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pavement being tended and would have been obvious to one of ordinary skill in the art.

A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

### ***Double Patenting***

6. Applicant is advised that should claim 4 be found allowable, claim 5 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Conclusion***

7. The machine translation of Suzuki (JP 11-321952 A) is provided to the applicant for informational purposes. A full translation of the Suzuki reference has been requested, but was not available at the time of the writing of this Office Action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. Gregory Pickett/  
Primary Examiner, Art Unit 3728